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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,718	04/04/2001	Yoji Furuya	36409-01100	3164
27171 7590 09/18/2007 MILBANK, TWEED, HADLEY & MCCLOY 1 CHASE MANHATTAN PLAZA NEW YORK, NY 10005-1413			EXAMINER POND, ROBERT M	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/825,718

Applicant(s)

FURUYA, YOJI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-53 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-53 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 31 July 2007 has been entered.

Response to Amendment

The Applicant amended claims 49-53 and 55. Claims 1-48, 54, and 56 are canceled. All pending claims 49-53 and 55 were examined in this non-final office.

Response to Arguments

Applicant's arguments, see Remarks, filed 31 July 2007, with respect to the rejection(s) of claim(s) 49-53 and 55 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Debry as the primary reference. Arguments based on Stefik as the primary prior art reference are moot. Debry discloses authenticating a printing

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device that can be connected to any or all computer systems used in the invention of Debry. Model and serial number information is used by the printer for authentication purposes in order to print documents that have protected usage rights and/or fees for use. Debry is attempting to solve the similar set of issues outlined by the Applicant's instant invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 49, 53 and 55 are rejected under 35 USC 103(a) as being unpatentable over Debry (US 6,314,521).

Debry teaches a system and method of printing copyright protected documents to a printer directly without requiring the originating requester to first download the document to the requester's computer or workstation. Debry teaches the owner of a file or document may wish to control the number of copies being distributed (e.g. to protect copyright in the document and/or payment of a fee on a per-copy basis). Debry teaches if a copy were resident on the client machine, illegal copies could be further made from that copy, or illegal changes could be made to the document. Debry teaches it may be more desirable if the

printer could get the document directly from wherever it may be stored and print the document and further teaches it is desirable to authenticate the printer (see at least abstract; col. 1, lines 29-52; col. 4, line 49-col. 5, line 8; col. 5, lines 47-49). Debry teaches a method whereby when an original request for a document is made, the document can be obtained from a third-party (i.e. supplier) and printed without first obtaining the file by the client system (i.e. computer, laptop, workstation as noted below) making the original request (see at least col. 5, lines 12-15). Debry further teaches the supplier (i.e. third-party) being guaranteed that the request is valid (i.e. printer has been authorized to get the file, and the original client can legally print the document) (see at least col. 5, lines 15-19). Debry states the terms printer, print server and printing system are used interchangeably herein. The printer is assumed to have the necessary functional capabilities to perform the required functions whether those functional capabilities are in a stand-alone printer connected to a network or a printer connected to a server i.e., computer, that manages the functions of the printer and device queuing where the dedicated is dedicated solely to such function or as part of its other functions such as a workstation computer, etc (see col. 10, lines 59-67). Debry teaches the computer systems themselves may vary from network terminals with minimal storage and CPU processing functionality to personal computers including laptop computers to workstations to servers to mainframes. The relationship among the computers can vary, e.g., as being independent from each other, or having distributed relationships, or having

client/server relationships, etc. Some or all of the files may be stored in a dedicated file storage system, e.g., a file server, database management system, etc., or within the storage of each system (see at least col. 1, lines 35-52). Debry further teaches:

- a determination step for determining whether a printer can guarantee safety of the image data on the basis of a model of said printer notified by said printer; When a printer is manufactured by a manufacturer 30, e.g., by IBM, the manufacturer gives each printer a serial number and a model number (or other unique identifier), and builds into each printer a unique encryption key, step 31. This key can be embodied in the printer hardware such as through mechanical or electrical switches or embodied in some persistent storage. For a secure embodiment, the key is embodied in such a way that it is tamper proof and not discernible. Its only use is by the printer controller 26 (FIG. 2) for encrypting a message that requests a digital certificate, or for decrypting the private key of the public/private key pair issued by the certificate authority (see at least Fig. 2; col. 8, lines 17-28). Printer is capable of authenticating itself (see at least col. 7, line 20-col. 9, line 46).
- and an image transmission step of transmitting the image data to said printer, when said determining step determines that said printer can guarantee the safety of the image data, once a printer is authenticated,

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data is transmitted to the printer (i.e. "on its way") (see at least col. 9, lines 45-50),

wherein said printer comprises:

- first connection means for connecting to a user device on a user side; printers may be attached to any or all of the systems and/or there may be print servers to which the computer systems can be communicatively linked (see at least col. 1, lines 49-52); the computer systems themselves may vary from network terminals with minimal storage and CPU processing functionality to personal computers including laptop computers to workstations to servers to mainframes. The relationship among the computers can vary, e.g., as being independent from each other, or having distributed relationships, or having client/server relationships, etc. Some or all of the files may be stored in a dedicated file storage system, e.g., a file server, database management system, etc., or within the storage of each system (see at least col. 1, lines 35-52). Please note: first connection means is printer attached to a client computer (e.g. personal computer, laptop, workstation).
- second connection means for connecting to said supplier device via the Internet; printers may be attached to any or all of the systems and/or there may be print servers to which the

computer systems can be communicatively linked (see at least col. 1, lines 49-52); the computer systems themselves may vary from network terminals with minimal storage and CPU processing functionality to personal computers including laptop computers to workstations to servers to mainframes. The relationship among the computers can vary, e.g., as being independent from each other, or having distributed relationships, or having client/server relationships, etc. Some or all of the files may be stored in a dedicated file storage system, e.g., a file server, database management system, etc., or within the storage of each system (see at least col. 1, lines 35-52).

Please note: second connection means for printer is network-attached for printer communication over the network to servers.

second connection means between a supplier server and a printer; when an original request for a document from a third-party is made the document can be obtained from the third-party and printed without first obtaining the file by the client system making the original request (see at least col. 5, lines 12-15).

Please note: print server (or standalone network-attached printer) makes request to third-party based on original request from client computer (please note: connection means between client computer and print server). Please note: client or personal

computer of first connection means makes original request to the print server or standalone printer connected to the network. Using Internet and Internet communication and security issues for networked attached printers (e.g. Internet) (see at least col. 5, lines 20-38).

- request reception means for connecting to said user device by said first connection means and receiving data from said user device; when an original request for a document is made the document can be obtained from the third-party and printed without first obtaining the file by the client system making the original request (see at least col. 5, lines 12-15). Please note: print server (or stand-alone printer) receives original request from client computer and makes request to third-party.
- notification means for connecting to said supplier device via the Internet by said second connection means, print server or stand-alone printer uses protocol to authenticate the printer with digital certificate containing printer serial number and model (see at least abstract; col. 6, lines 18-67; col. 8, lines 17-29; col. 8, line 65-col. 9, line 46). Debry teaches there is a need to allow a print server to get a print file from a third party identified in an original request so that the document can be printed without first obtaining the file by a client system originally requesting the

print file. However, when the print server gets the file, the third party must be guaranteed that the request is valid (i.e., the print server has been authorized to get the file, and the original client can legally print the document (see at least col. 5, lines 12-21).

Although Debry does not mention and notifying said supplier device of the request data and a model of said printer, it would have been obvious to one of ordinary skill in the art at time the invention was made to ascertain that either directly or indirectly the third party supplying the document relied upon printer model information since the third party supplier completed the request by sending the document to the authenticated printer.

- image reception means for connecting to said supplier device via the Internet by said second connection means and receiving image data corresponding to the request data from said supplier device; print server or stand-alone printer makes request to third-party supplier as requested by client computer as previously noted above.
- and printing means for printing the image data received.
document is printed without having to retrieve and store in client computer as noted above.

Pertaining to system claims 49 and 53

Rejection of claims 49 and 53 is based on the same rationale as noted above.

- 2. Claims 50 and 52 are rejected under 35 USC 103(a) as being unpatentable over Debry (US 6,314,521) in view of Stefik (Paper #20061125, US 6,233,684).**

Debry teaches all the above as noted under the 103(a) rejection and teaches i) second connection means for connecting to said supplier device via the Internet, ii) using the Internet for transferring a document to an authenticated printer from a third-party (i.e. supplier of the document) without first having to retrieval and store in a client computer, and iii) owner of the file (i.e. document) wishing to control the number of copies being distributed to protect document copyright and/or payment of a fee on a per-copy basis. Although Debry does not mention and transmitting, to said supplier device, charge information in response to print by said printing means, Debry in combination with Stefik teach and suggest the claimed invention. Stefik teaches problems pertaining to rights protection of printed digital works. Stefik teaches a trusted system and method of rendering digital works by a trusted printer connected to a trusted server over a network (e.g. Internet) and further teaches the trusted printer connected to a user's personal computer (see at least abstract; Fig. 3; col. 3-col. 8). Stefik teaches a loan right may be defined so as to limit the duration of which a work may be loaned. Conditions may also include requirements that fees be paid. Please note: limit duration established a pre-defined time limited (see at least col. 5, lines 55-59). Stefik further teaches the trusted printer repository 302 will in

some instances contain an ephemeral copy of a digital work which remains until it is printed out by the print engine 303 (please note: deletion means for deleting image data). In other instances, the printer repository 302 may contain digital works such as fonts, which will remain and be billed based on use (see at least col. 7, lines 29-35). Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the system and method of Debry to delete a digital work based on a time duration and transmit charge information in response to print by said print means as taught by Sefik, in order to remove digital works and to report copyright usage to the supplier of the digital work.

- 3. Claims 51 is rejected under 35 USC 103(a) as being unpatentable over Debry (US 6,314,521) in view of Stefik (Paper #20061125, US 6,233,684) as applied to claim 49, further in view of Rager (Paper #5, US 5,363,447).**

Debry teaches all the above as noted under the 103(a) rejection and teaches i) second connection means for connecting to said supplier device via the Internet, ii) using the Internet for transferring a document to an authenticated printer from a third-party (i.e. supplier of the document) without first having to retrieval and store in a client computer, and iii) owner of the file (i.e. document) wishing to control the number of copies being distributed to protect document copyright and/or payment of a fee on a per-copy basis. Although Debry does not mention and transmitting, to said supplier device, charge information in response

to print by said printing means, Debry in combination with Stefik teach and suggest the claimed invention. Stefik teaches problems pertaining to rights protection of printed digital works. Stefik teaches a trusted system and method of rendering digital works by a trusted printer connected to a trusted server over a network (e.g. Internet) and further teaches the trusted printer connected to a user's personal computer (see at least abstract; Fig. 3; col. 3-col. 8). Stefik teaches a loan right may be defined so as to limit the duration of which a work may be loaned. Conditions may also include requirements that fees be paid. Please note: limit duration established a pre-defined time limited (see at least col. 5, lines 55-59). Stefik further teaches the trusted printer repository 302 will in some instances contain an ephemeral copy of a digital work which remains until it is printed out by the print engine 303 (please note: deletion means for deleting image data). In other instances, the printer repository 302 may contain digital works such as fonts, which will remain and be billed based on use (see at least col. 7, lines 29-35). Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the system and method of Debry to delete a digital work based on a time duration and transmit charge information in response to print by said print means as taught by Stefik, in order to remove digital works and to report copyright usage to the supplier of the digital work.

Debry and Stefik teach all the above as noted under the 103(a) rejection and teach and suggest i) storing charging information in memory, ii) storing print data

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in an authenticated printer, iii) encrypting print data to make it tamper proof, and iv) deleting information once printed or saving it for repeated use, but do not mention deleting information upon detecting a power-off condition. On the other hand, Rager teaches erasing memory to maintain data security in the event that a device is tampered with or powered down (see at least col. 1, lines 64-67; col. 4, lines 37-49). Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to combine Rager with Debry and Stefik. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods who no change in the respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at time the invention was made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond
Primary Examiner
September 16, 2007